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TECH GENET NO 4830.P RE  
ATTORNEY DOCKET NO 1600/2900 PATENT

#19/Attor

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: ROMERO	) I hereby certify that
Serial No. 09/313,534	) this paper is being
Filed: May 13, 1999	) deposited with the United
Title: HETEROCYCLIC AMINES	) States Postal Service as
HAVING CENTRAL NERVOUS	) first class mail in an
SYSTEM ACTIVITY	) envelope addressed to:
	) Commissioner for Patents,
	) Washington, DC 20231.
	)
Group Art Unit: 1625	) July 3, 2002
	)
Examiner: P. Morris	) <u>Mark H. Hopkins</u>
	)
Attorney Docket No. 4830.P	) Mark H. Hopkins, Ph.D.
RE	) Reg. No. 44,775
	) Agent for Applicants

RENEWED PETITION FROM RESTRICTION REQUIREMENT UNDER 37  
C.F.R. § 1.144

Commissioner For Patents  
Washington, DC 20231

Sir:

This "renewed petition" is submitted under 37 C.F.R. § 1.144 to request reconsideration of the two-way restriction requirement formulated a Petition Decision dated May 3, 2002. This "renewed petition" is timely filed within two months of the mailing date of the previous petition decision. Any fees that may be due are authorized to be charged to Marshall, Gerstein, & Borun deposit account number 13-2855. The petitioners respectfully petition for reconsideration in view of the following remarks.



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STATEMENT OF THE FACTS INVOLVED  
THE REQUIREMENT FOR RESTRICTION

TECH CENTER 1600/2900

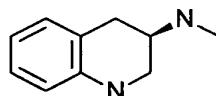
In the Petition Decision dated May 3, 2002 the Patent Office reformulated the restriction between the claims of new Group I (claims 1-8 and 12), drawn to tricyclic compounds and methods of use; and new Group II (claims 9-11), drawn to bicyclic compounds. The petition decision is attached as Exhibit 1. A copy of the claims are attached to an amendment filed herewith. The Applicants acknowledge with thanks, the reduction of the old restriction requirement from five groups to two.

On page 3 of the May 13, 2002, Petition Decision, the director stated that "the compounds of claims 9-11, which are to substituted quinoline compounds, are sufficiently different from the claimed compounds as to be considered and independent and distinct invention."

POINTS TO BE REVIEWED

The petitioners hereby request review and withdrawal of the requirement for restriction, particularly on the bases of the accompanying amendment. New claim 13, presents in a single claim, the compounds of the claims of Group I and Group II, such that the Group I and Group II claims should not be considered independently and distinct inventions, or in any event, should not be restricted from each other. As the Director pointed out in the petition decision on page 3, with regard to claims 9-11 "had [the claims] they been presented in a single application, no restriction between them would have been possible as they all have the same bicyclic ring system and vary only in their

substituents." With the introduction of claim 13 into the application, the same reasoning now applies to all subject matter. The searching of these compounds should not "present a burden to the examiner due to the similarity to the patented compounds" (Petition Decision, p. 3). It is respectfully submitted that the compounds recited in claims 1-13 all possess the following amine-substituted bicyclic core structure:



Accordingly, it is submitted that the claimed compounds are sufficiently related that all claims can be included in one search without an undue burden on the examiner and should be examined at this time. The Patent and Trademark Office has, on numerous occasions, searched and examined bicyclic and tricyclic compounds together. For example, applicant draws the Examiner's attention to claims 1 and 38 of U.S. Patent No. 5,932,553 (Exhibit 2). This patent discloses tricyclic compounds of claim 1 that are useful as intermediates for preparing the bicyclic compounds recited in claim 38. See for example, column 14, lines 20-42, where the tricyclic compound HMAF is converted to the bicyclic compound 45. In the '553 application, claims to tricyclic compounds and bicyclic compounds were searched, examined, and allowed in one application. Thus, the action requested by Applicant is not without precedent. Search and examination of all groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in two separate applications.

In light of the above remarks, applicant respectfully requests that the Patent Office reconsider and withdraw the restriction requirement.

**ACTION REQUESTED**

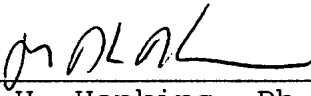
For the reasons set forth above, the petitioners hereby respectfully request the Patent Office withdraw the requirement for restriction and an early and favorable action on the merits on all pending claims in the application.

Should the Patent Office wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the Patent Office is urged to telephone the undersigned at the indicated number.

Respectfully submitted, :

**MARSHALL, GERSTEIN & BORUN**

By: \_\_\_\_\_

  
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